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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,645	10/20/2003	Jean-Christophe Simon	23705-4US0	1828
22850 7590 05/06/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MERCIER, MELISSA S				
ART UNIT 1615		PAPER NUMBER		
NOTIFICATION DATE 05/06/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/687,645

**Applicant(s)**

SIMON ET AL.

**Examiner**

MELISSA S. MERCIER

**Art Unit**

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2-4-09, 3-20-09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,10,12-16,20-43 and 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,10,12-16,20-43 and 47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date 2-4-09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2009 and March 20, 2009 has been entered.

### ***Information Disclosure Statement***

Receipt of the Information Disclosure Statement filed on February 4, 2009 is acknowledged. A signed copy is attached to this office action.

### ***Maintained Rejections/Objections***

#### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

***Response to Arguments***

Applicant has again not responded to the objection to the oath, therefore the objection is maintained.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 5, 10, 12-16, 20-43, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clarke et al. (US Patent 6,294,112) in view of Lagrange (US Patent 6,123,952) and further in view of Polonka et al. (US Patent 6,369,147).

Clarke discloses red coloring hyper chromic compounds with the formula of instant claim 1A (abstract).

Clarke does not disclose using the compound in a cosmetic composition.

Lagrange discloses a cosmetic composition comprising a photo chromic compound. LaGrange discloses the photo chromic compounds are compounds which have the property of changing color when they are irradiated with a light source and then regaining their initial color when the irradiation stops (column 1, lines 43-46) The composition can be in any cosmetically acceptable pharmaceutical form, such as in the form of a lotion, suspension, dispersion or solution in aqueous-alcoholic or solvent medium, which may be multi-phasic; in the form of a gel, a mousse, a spray, an oil-in-water, water-in-oil or multiple emulsion; in the form of a free, compact or cast powder; in the form of an anhydrous solid or paste (column 3, lines 46-54).

The photo chromic coloring agent is present in the amount of 0.05-30% by weight (column 6, lines 27-28). The composition also contains a cosmetically acceptable medium (column 6, lines 34-35). A fatty phase may be present comprising oils of animals, plants, mineral or synthetic origin, waxes of animal, plant, mineral, or synthetic origin, pasty fatty substances, gums, or mixtures thereof (column 6, lines 46-52). Volatile oils may also be present, such as cyclic volatile silicones, cyclocopolymers, and linear volatile silicones; non volatile oils may be used, such as poly(C1-C20) alkylsiloxanes, silicones modified with aliphatic or aromatic groups, phenylsilicones, oils of animal plant, or mineral origin, fluoro oils and perfluoro oils (column 6, line 54-column 7, lines 64).

The aqueous phase can comprise from 0% to 14% by weight, relative to the total weight of the aqueous phase, of a C2-C6 lower monoalcohol and/or of a polyol such as glycerol, butylene glycol, isoprene glycol, propylene glycol or polyethylene glycol (column 8, lines 54-58).

When the composition is in the form of an emulsion, it can also comprise a surfactant, in an amount of from 0.01 to 30% by weight relative to the total weight of the composition (column 8, lines 59-63). The composition can also comprise one or more thickeners in concentrations ranging from 0 to 6% by weight, relative to the total weight of the emulsion (column 9, lines 45-48).

The composition can also comprise a film-forming polymer. The polymers can be dissolved or dispersed in the cosmetically acceptable medium. In particular, the polymer

can be present in the form of a solution in an organic solvent or in the form of an aqueous dispersion of film-forming polymer particles (column 10, lines 4-12).

The composition can also comprise a particulate phase, which can comprise pigments and/or pearlescent agents and/or fillers usually used in cosmetic compositions (column 10, lines 65-68). The fillers, which can be present, are in a proportion of from 0 to 30% by weight (column 11, lines 34-35). Pigments include white or colored, inorganic or organic particles intended to color or opacify the composition (column 11, lines 1-2), iridescent particles which reflect light (column 11, lines 8-9), and lakes and dyes (column 11, lines 16-25).

Neither Clarke nor Lagrange teaches composition comprising a goniochromatic agent to be used along with the naphthopyran containing composition.

Polonka discloses a cosmetic composition comprising a metallic effect pigment comprising an instant effect pigments have a high gloss, attractive goniochromatic shifts generally with a high dark flop effect, as well as surprisingly vivid, saturated colors and a good hiding power (column 4, lines 7-10). For producing a mixed interference/absorption effect pigment, the metal oxide of dielectric layer is a colored oxide or colored mixed oxide of elements of groups 5 to 12 (column 4, lines 43-46). For producing a pure interference effect pigment, the metal oxide of dielectric layer (c) is preferably a substantially colorless oxide of an element of groups 3 or 4 (column 4, lines 60-63).

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of each component, to prepare a composition containing a photo chromic dye for application as a cosmetic composition because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

It would have been obvious to a person of ordinary skill in the art to use the composition taught by Polonka in conjunction with the one taught by Krongauz and Lagrange in order to obtain a cosmetic product in which the effect pigment particles incorporated therein will, within the coating, align themselves parallel to the surface so that the colored paint surface, when illuminated by a fixed white light source may display different colors or will appear to have an iridescent color depending on the viewing angle (column 1, lines 7-15). It is within the skill and the knowledge of the person of ordinary skill in the art to coordinate composition in order to obtain the desired make up effect.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues:

\*the applied art does not teach or suggest using the claimed photochromic compounds in a cosmetic formulation,

The Examiner has readily conceded this matter, as it was clearly iterated in the body of the rejection. However, Clarke discloses the compound is a known hyperchromic coloring compound. There is nothing of record, nor any indication in the art that this particular compound would be considered incompatible as a cosmetic colorant.

\*Applicant additionally appears to be arguing each reference alone. In response, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Clarke discloses the claimed compound of formula 1A is a known coloring agent, Lagrange disclose the use of the same class of compounds to be used in cosmetic formulations.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the cited references Lagrange and Polonka both disclose the use of the two different coloring



compounds to be used in a cosmetic formulation with their desired aesthetic effects, therefore, based on these teachings and their disclosure of their effects, it would have been obvious to one of ordinary skill to combine the two colorants with the expectation that such a combination would result in a new effect.

Therefore, the rejection is maintained.

### ***Response to Amendment***

The Declaration under 37 CFR 1.132 filed March 20, 2009 is insufficient to overcome the rejection of claims 1-2, 5, 10, 12-16, 20-43, and 47 based upon new unique properties as set forth in the last Office action because: a composition can not be separated from its properties. Applicant has merely identified a property of the composition. The Declaration is comparing properties of two different compounds (i.e. the photo chromic compounds); however, one of ordinary skill would expect the two different compounds to possess different aesthetic effects, as was clearly demonstrated in the declaration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/  
Examiner, Art Unit 1615

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615